UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,904	02/26/2004	James J. Enright	ENRIGHT 21.016 (101353-00	4538

			EXAMINER
26304	7590	11/22/2005	THAI, CANG G

KATTEN MUCHIN ROSENMAN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.</td><td>Applicant(s)</td></tr>
<tr><td>10/788,904</td><td>ENRIGHT, JAMES J.</td></tr>
<tr><td>Examiner</td><td>Art Unit</td><td></td></tr>
<tr><td>Cang G. Thai</td><td>3629</td><td></td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 August 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-31, 33-37* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-31, 33-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

The amendment filed on 08/25/2005 has been entered.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claim 13-31 and 33-37 are rejected under 35 U.S.C. 102(b) as being anticipated

by U.S. Patent No. 4,797,830 (BAGGARLY ET AL.).

As for claim 13, BAGGARLY discloses a postal object selecting method in a mail

packaging system, comprising the steps of:

identifying a plurality of customers {Column 1, Lines 52-53, wherein this reads

over "the sender may send certain general interest enclosures to all customers"};

identifying a plurality of postal objects {Column 1, Lines 54-55, wherein this reads

over "enclosing one or more of many special interest enclosures to select or targeted

customers"};

determining an access charge for each object by an associate customer, said

determining comprising the steps of:

determining an expected gross profit from the customer,

determining a probability of success of the object with respect to the customer,

and

determining provisioning costs for the object {Column 2, Lines 14-15, wherein this reads over "an inserter machine which is easily operated for determining the accurate weight of an envelope and its associated required contents"}. Accurate weight of an envelope would determine the costs.

determining an expected return on investment from one or more of the plurality of customers for one or more of plurality of objects based on the determined access charge; and

selecting one or more objects to be assembled into a mail package for one of said plurality of customers, such that an expected return on investment from the customer object is substantially the same for each of the plurality of customers {Column 2, Lines 9-11, wherein this reads over "accurate determination of the weight of an envelope and its associated required inserts, results in a substantial financial savings"}.

As for claim 14, BAGGARLY discloses the method of claim 13, further comprising the step of:

Determining an expected value of the mail package, wherein

the selecting step selects the one or more objects from the plurality of objects to be assembled into the mail packages, such that the expected value for the mail package is maximized {Column 2, Lines 13-15, wherein this reads over "an inserter machine which is easily operated for determining the accurate weight of the envelope and its associated required contents"}.

As for claim 15, BAGGARLY discloses the method of claim 14, wherein the expected value for the mail package is a function of the access charge for each

selected object and the provisioning costs, and object selection is subject to one or more predetermined constraints {Column 2, Lines 22-26, wherein this reads over "inserter machine which includes the maximum possible number of the optional advertising inserts for stuffing with a customer's envelope without increasing the postage amount required by the stuffed envelope"}.

As for claim 16, BAGGARLY discloses the method of claim 15, wherein each object has an object type selected from the group consisting of outgoing envelopes, primary documents, return envelopes, and inserts {Column 9, Lines 39-43, wherein this reads over "telephone billing documents, for example, in the manner afore described, the data processor 102 must be supplied with information relative to the per document weight of the documents at each of the stations 31, 32, 33, 34, 35, 36, 37, and 42}.

As for claim 17, BAGGARLY discloses the method of claim 16, wherein the one or more predetermined constraints include at least one of a weight constraint and a number of objects constraint for each mail package {Column 6, Lines 6-8, wherein this reads over "first postage meter 84 is preset to apply appropriate postage to a stuffed envelope weighing in the range from 1.00 ounces to 1.99 ounces"}.

As for claim 18, BAGGARLY discloses the method of claim 17, wherein the number of objects constraint specifies at least one of a minimum number of objects constraint {Fig. 1, Element 88} and a maximum number of objects constraint for each of one or more of the object types {Fig. 1, Element 62}.

As for claim 19, BAGGARLY discloses the method of claim 15, wherein object selection is also determined as a function of managerial prerogatives {Column 3, Lines

63, wherein this reads over "on mode (the "select" mode) the first document feed from

the station 31 with respect to each customer functions as a control document which to

extent governs downstream operations"}.

As for claim 20, BAGGARLY discloses the method of claim 19, wherein the

managerial prerogatives may specify a status by customer for each selectable object,

which specified status includes one of "do not use", "absolute priority", "high priority"

and "normal priority" {Column 1-2, Lines 68 & 1-2, wherein this reads over "the general

interest and special interest informational enclosures, are high priority "required" items

for inclusion in a customer's envelope"}.

As for claim 21, BAGGARLY discloses the method of claim 17, wherein the

weight constraint is specified as a total weight of all objects included in the mail package

{Column 2, Lines 16-18, wherein this reads over "an inserter machine which is easily

operated for determining the accurate weight of an envelope and its associated required

contents"}.

As for claim 22, BAGGARLY discloses the method of claim 18, wherein ones of

the one or more objects selected for each mail package are assembled into one or more

object packets, and the mail package is assembled from at least one of the one or more

object packets one or more of the plurality of objects {Column 2, Lines 41-47, wherein

this reads over "third-party advertising documents are fed from one or more

downstream insert stations if the indicia on the master control document so authorizes

and if and only if the additional weight occasioned by the feeding of the advertising

document s would not cause an increase in the package for the customer's stuffed envelopes"}

As for claim 23, BAGGARLY discloses the method of claim 22, wherein the one or more object packets and/or single objects are assembled by offline processing {Column 2, Lines 30-31, wherein this reads over "an insertion machine a first insert station feeds one or more sheets for a customer onto a conveyor"}.

As for claim 24, BAGGARLY discloses the method of claim 23, wherein the plurality of mail packages are assembled by online processing {Column 3, Lines 56-58, wherein this reads over "the documents fed by the feeder of station 31 during a given machine cycle are all associated with a particular customer"}.

As for claim 25, BAGGARLY discloses the method of claim 24, wherein the one or more object packets produced by offline processing are stored in a packet storage device and retrieved for online processing {Column 9, Lines 39-43, wherein this reads over "telephone billing documents, for example, in the manner afore described, the data processor 102 must be supplied with information relative to the per document weight of the documents at each of the stations 31, 32, 33, 34, 35, 36, 37, and 42"}.

As for claim 26, BAGGARLY discloses the method of claim 24, wherein the storage and retrieval steps are performed by one or more packet retrieval transfer devices {Column3, Lines 25-30, wherein this reads over "during successive machine cycles a document on conveyor 20 travels in a leftward direction so that during the machine cycle MC2 the document is proximate the station 32; in the machine cycle MC3 the document is proximate the station 33, and so forth"}.

As for claim 27, BAGGARLY discloses the method of claim 15, wherein the selection step is performed using goal integer programming {Column 17, Lines 29-32, wherein this reads over "once programming of the insertion machine has been accomplished using the program mode, and when documents are ready to be feed from the feeder station 31, the insertion machine operation is ready to enter the calculation mode"}. It appears this step also performed using the goal integer programming.

As for claim 28, BAGGARLY discloses the method of claim 15, wherein provisioning costs include printing and ink costs {Column 29,Lines 3-8, wherein this reads over "the sender includes the advertising literature of the third parties in appropriate envelopes mailed to the sender's customers if the inclusion of the advertising literature does not increase the sender's postage cost for each customer"}. It appears that the cost including printing and ink costs would be included in the advertising literature.

As for claim 29, BAGGARLY discloses the method of claim 18, wherein the one or more object types include inserts {Column 5, Lines 14-16, wherein this reads over "the sender has agreed to include one or both of the advertising inserts in stuffed envelopes for one of the sender's"}.

As for claim 30, BAGGARLY discloses the method of claim 19, wherein the selection step is performed using goal integer programming {Column 17, Lines 29-33, wherein this reads over "once programming of the insertion machine has been accomplished using the program mode, and when documents are ready to be fed from

the feeder station 31, the insertion machine operation is ready to enter the calculation

mode"}.

As for claim 31, BAGGARLY discloses an object selecting method in a packaging

system, comprising the steps of:

identifying a plurality of customers {Column 1, Lines 52-53, wherein this reads

over "the sender may send certain general interest enclosures to all customers"};

identifying a plurality of objects {Column 1, Lines 54-55, wherein this reads over

"enclosing one or more of many special interest enclosures to select or targeted

customers"};

determining an access charge for each object by customer, which access fee is

variably determined {Column 2, Lines 9-11, wherein this reads over "accurate

determination of the weight of an envelope and its associated required inserts, results in

a substantial financial savings"}. The access fee is included in a substantial financial

savings.

determining an expected return on investment from one or more of the plurality of

customers for one or more of said plurality of objects based on the determined access

charge {Column 4, Lines 57-58, wherein this reads over "station 33 may contain an

enclosure which is to be sent only to customers whose bill is overdue"}. The investment

is on the customers whose bill is overdue.

selecting one or more objects to be assembled into a package for one of said

plurality of customers, such that the expected return on investment from the customer

for said package is substantially the same for each of the one or more of the plurality of

customers {Column 4, Lines 58-62, wherein this reads over "station 34 may contain an

enclosure which may announce a future additional service to be provided by the sender,

station 35 may contain an enclosure targeted to special customers such as the elderly"}.

As for claim 33, which has the same limitations as in claim 14, therefore it is

rejected for the similar reason set forth in claim 14.

As for claim 34, which has the same limitations as in claim 15, therefore it is

rejected for the similar reason set forth in claim 15.

As for claim 35, BAGGARLY discloses the method of claim 34, wherein the

plurality of objects includes sales offers for unsold airline seats {Column 5, Lines 29-32,

wherein this reads over "the sender determines the number of advertising inserts fed on

behalf of each third party and charges the third party a per insert fee for the sender's

service"}. It appears that the number advertising inserts fed on behalf of each third part

would also be the airline.

As for claim 36, BAGGARLY discloses the method of claim 34, wherein the

plurality of objects includes sales offers for unsold shipping capacity {Column 5, Lines

29-32, wherein this reads over "the sender determines the number of advertising inserts

fed on behalf of each third party and charges the third party a per insert fee for the

sender's service"}. It appears that the number advertising inserts fed on behalf of each

third part would also be the shipping.

As for claim 37, BAGGARLY discloses the method of claim 34, wherein the

plurality of objects includes sales offers to be provided in postal mail packages directed

to each of the plurality of customers {Columns 4-5, Lines 66-68 & 1-2, wherein this

reads over "the indicia 50 on control document 46 requires that the inserts from these selected stations be included with the sheets comprising the customer's bill (fed from station 31) and the billing card (fed from station 32) in the customer's stuffed envelope"}.

Response to Arguments

3.   Applicant's arguments filed 08/25/2005 have been fully considered but they are not persuasive.

BAGGARLY discloses determining an expected return on investment form one or more of the plurality of customers or more of the plurality of objects based on a determined access charge in Column 5, Lines 14-21, wherein this reads over "the sender has agreed to include one or both of the advertising inserts in stuffed envelopes for each of the sender's customers if and only if the additional weight of the optional advertising inserts will not cause the customer's stuffed envelope to incur postage in addition to the amount determined for the already projected postage categorization range"}

Conclusion

4.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

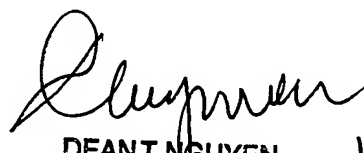than SIX MONTHS from the mailing date of this final action.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cang G. Thai whose telephone number is (571) 272-

6499. The examiner can normally be reached on 6:30 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

CGT
11/08/2005

DEAN T. NGUYEN
PRIMARY EXAMINER